UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte JONATHAN E. LOWTHERT and OLEG RASHKOVSKIY

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Appeal 2009-0157
Application 09/766,125
Technology Center 2600

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Decided:[1] May 18, 2009

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Before JOSEPH F. RUGGIERO, MAHSHID D. SAADAT,
and KARL D. EASTHOM, *Administrative Patent Judges*.

RUGGIERO, *Administrative Patent Judge*.

DECISION ON APPEAL

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[1] The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1,304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from the Final Rejection of claims 62-90. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Brief filed May 21, 2007, the Answer mailed October 9, 2007, and the Reply Brief filed December 3, 2007 for the respective details. Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Appellants' Invention

Appellants' invention relates to the insertion of advertisements into a content item such as a movie. An "info segment" is transmitted which includes a content identifier to specify a particular content item and an interruption point specifier. The interruption point specifier identifies a condition which, if detected during display of the particular content item, causes the display of an advertisement to replace the display of the particular content item. (*See generally* Spec. 2:8-9 and 6:1-22).

Claim 62 is illustrative of the invention and reads as follows:

62.   A system comprising:

a transmitter to transmit an info segment including a content identifier to specify one particular content item, said info segment also including an interruption point specifier to identify a condition that, if

detected during the display of the particular content item, will cause the display of an advertisement to replace the display of said one particular content item, wherein prior to a use of the particular content item, the place in the content where the replacement might happen, as a result of the detection of the condition during use of said one particular content item, is not known; and

a storage to store said info segment until said info segment is transmitted to a receiver.

The Examiner's Rejections

The Examiner's Answer relies on the following prior art references:

Knepper	US 2001/0042249 A1	Nov. 15, 2001 (filed Feb. 12, 2001)[2]
Rosenberg	US 2002/0100041 A1	Jul. 25, 2002 (filed Oct. 15, 2001)[3]
Zigmond	US 6,698,020 B1	Feb. 24, 2004 (filed Jun. 15, 1998)

Claims 62, 63, 65, 66, 68-74, 77, and 79-90 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Knepper in view of Rosenberg.[4]

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[2] The benefit of U.S. Provisional Application No. 60/189,398, filed March 15, 2000, under 35 U.S.C. § 119(e) is claimed.

[3] The benefit of U.S. Provisional Application Nos. 60/240,715 and 60/240,714, both filed October 15, 2000, under 35 U.S.C. § 119(e) is claimed

[4] The Examiner did not include dependent claim 68 in the heading statement of the grounds of rejection (Ans. 3). The Examiner did include claim 68, which is not separately argued by Appellants, in the detailed discussion (Ans. 6) of the rejection. Accordingly, we treat the Examiner's failure to include claim 68 in the heading statement of the rejection as an inadvertent harmless error.

Claims 64, 67, 75, 76, and 78 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Knepper in view of Rosenberg, and further in view of Zigmond.

ISSUES

Under 35 U.S.C. § 103(a), with respect to appealed claims 62-90, would one of ordinary skill in the art at the time of the invention have found it obvious to combine Knepper with Rosenberg, with the further addition of Zigmond, to render the claimed invention unpatentable?

The pivotal issues before us are whether Appellants have demonstrated that the Examiner erred in:

(i)   determining that Knepper provides a disclosure of transmitting an "info segment" instruction set to a user that includes an "interruption point specifier," which identifies a condition to be detected during playback of a content item that will cause an advertisement to replace the content item;

(ii)   determining the obviousness to the ordinarily skilled artisan of applying the user initiated pause function advertisement insertion teachings of Rosenberg to Knepper; and

(iii)   further determining the obviousness to the ordinarily skilled artisan of applying the electronic programming guide teachings of Zigmond to the combination of Knepper and Rosenberg.

FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence:

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1.   Knepper discloses (¶ [0064]) an instruction set transmitted from a server to a client that includes an identification of a content identifier which identifies a particular content item, such as a movie or a show.

2.   Knepper also discloses (¶¶ [0009], [0078], and [0079]) that the instruction set includes tags which indicate the places in the content item where advertisements are to be inserted.

3.   A particular tag described by Knepper ([¶ [0080]) is the EADOK tag, the true or false condition of which is detected during payback of a show to cause the insertion of an advertisement into the show.

4.   Knepper also discloses (¶¶ [0031]-[0037] that the instruction set transmitted to the client may be modified to provide for the random insertion of advertisements.

5.   The instruction set modification is disclosed by Knepper (Fig. 3, 8a, and 8b; ¶¶ [0080]-[0084]) as taking place before the media files for the show are assembled and before the use of the show content.

6.   Rosenberg discloses (Abstract; ¶¶ [0009] and [0115-0117]) the detection of a condition, i.e., a pause function entered by a user, during playback of a content item and, upon detection of such condition, an advertisement is inserted into and replaces the content item.

7.   The Rosenberg reference has a filing date of October 15, 2001 which is after the January 19, 2001 filing date of the present application, but claims the benefit under 35 U.S.C. 119(e) of provisional application (US 60/240,714) filed October 15, 2000.

8.   Rosenberg's provisional application (US 60/240,714) discloses (page 8, last paragraph) the feature of advertisement insertion after the

detection of a "pause" function chosen by a user, which feature is further described in the "Pause Ads" section beginning at page 21.

     9.   Zigmond discloses (col. 11, ll. 1-2 and ll. 45-46) a video program advertisement insertion system that stores program identifying information at a user's premises, which information is associated with specific time slots and program channels.

PRINCIPLES OF LAW

     In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966) (stating that 35 U.S.C. § 103 leads to three basic factual inquiries: the scope and content of the prior art, the differences between the prior art and the claims at issue, and the level of ordinary skill in the art). "[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability." *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Furthermore,

> 'there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness' . . . [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.

KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 418 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

Also, "'[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.'" *Leapfrog Enter., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (quoting *KSR*, 550 U.S. at 416). "One of the ways in which a patent's subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent's claims." *KSR*, 550 U.S. at 419-20.

ANALYSIS

I.   THE REJECTION OF CLAIMS 62, 63, 65, 66, 68-74, 77, and 79-90 BASED ON THE COMBINATION OF KNEPPER AND ROSENBERG.

Claims 62, 66, 68, 70-72, 74, 77, 79, 80, 82, 83, 85, and 89

With respect to the Examiner's obviousness rejection of independent claims 62, 71, and 79 based on the combination of Knepper and Rosenberg, Appellants' arguments in response assert a failure by the Examiner to establish a prima facie case of obviousness since all of the claimed limitations are not taught or suggested by the applied prior art references. Appellants' arguments initially focus on the alleged deficiency of Knepper in disclosing the claimed feature of replacing a content item with an advertisement where the place in the content item where the replacement might occur is unknown. According to Appellants (App. Br. 13-14), Knepper discloses a system in which a client receives an instruction set that

lists the predetermined, i.e. known, order of the entertainment files and the advertisement files which make up a requested show.

In support of their position, Appellants direct attention to the illustration in Knepper's Figure 3, described at paragraphs [0031]-[0037] of Knepper which indicates that, even though the instruction set may be modified to provide for the random insertion of advertisements, such modification takes place before the media files for the show are assembled (294). Appellants contend (*id.*), therefore, that, since the instruction set modification and files assembly takes place before the show begins playing (288), the place in the show where advertisements are inserted is *known* prior to use of the content item which is contrary to what is claimed.

On this particular point of contention, we find ourselves in agreement with Appellants. Although the Examiner, at pages 19 and 20 in the responsive arguments portion of the Answer, makes reference to paragraphs [0080]-[0084] of Knepper in support of the position that Knepper discloses that advertisement placement is *unknown* prior to use of the content item, we find no basis for this conclusion either in the cited portion, or elsewhere, in Knepper. Knepper does indeed disclose in the cited sections that the instruction set for the requested show can be modified in "real-time" ([¶ [0083]) to allow for random insertion of advertisements into the show content files, or that location of the advertisement takes place "at the time of playback" (¶ [0084]). It is apparent, however, that any such modification of the requested show instruction set is taking place before the media files for the requested show are assembled and, accordingly, the placement of the advertisements is *known* prior to use of the content files. Further evidence of the operation of Knepper appears in the illustrated flow chart in

Knepper's Figures 8a-8b described at paragraphs [0085]-[0091] of Knepper. As indicated, before play begins (825), the media files including the places where advertisements are to be inserted are assembled according to a precompiled download list (821 and 823).

We do not agree, however, with Appellants' further argument (App. Br. 14-15; Reply Br. 1-4) that the Examiner has mischaracterized the presence of Knepper's EADOK tag as teaching the claimed "interruption point specifier." We find evidentiary support in Knepper (¶¶ [0079] and [0080]) to support the Examiner's position that the EADOK tag, which is part of the "info segment" instruction set transmitted from the server to the client, corresponds to the claimed "interruption point specifier." As set forth by the Examiner (Ans. 21), the state condition (i.e., true or false) of the EADOK tag is detected during the playing of the requested show which enables advertisements to be inserted into the show.

Despite our agreement with Appellants that Knepper does not disclose the claimed feature of replacing a content item with an advertisement, where the place in the content item that the replacement might occur is unknown prior to use of the content item, we do agree with Examiner (Ans. 4) that any such deficiency in the disclosure of Knepper is overcome by the application of the teachings of Rosenberg. We agree with the Examiner's finding (*id.*) that Rosenberg discloses (Abstract; ¶¶ [0009], [0041], [0050], and [0115-0117]) the detection of a condition, i.e., a pause function entered by a user, during playback of a content item and, upon detection of such condition, an advertisement is inserted into and replaces the content item.

Appellants' arguments in response to the Examiner's proposed combination of Knepper and Rosenberg assert that Rosenberg's teachings

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are not applicable to the system disclosed by Knepper. According to Appellants (App. Br. 15), Rosenberg's disclosure specifically describes the format of the advertising that is inserted into a show upon the user pressing of a "Pause" button is a "static bit map," and is not directed to the playing of media files from a predetermined list of files as in Knepper.

It is apparent to us, however, from the Examiner's stated position (Ans. 4) that the Examiner is not suggesting the bodily incorporation of the static bit map formatted advertisement feature of Rosenberg into the content item display system of Knepper. Rather, as emphasized by the Examiner (Ans. 21), it is Rosenberg's teaching of placing an advertisement into a show, where the placement of the advertisement is unknown prior to the show upon detection of a condition *during* the show, i.e., user actuation of a "Pause" function, that is relied on as a rationale for the proposed combination with Knepper's system. "The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference.... Rather, the test is what the combined teachings of those references would have suggested to those of ordinary skill in the art." *See In re Keller*, 642 F.2d 414, 425 (CCPA 1981) and *In re Nievelt*, 482 F.2d 965, 968 (CCPA 1973). Appellants' further argument (Reply Br. 4) that Rosenberg's detected "Pause" condition is not defined by a transmitted "info segment" as claimed is not persuasive since the teaching of detecting a condition that is defined by a transmitted "info segment" is provided by Knepper.

Further, we find, and there are no convincing arguments to the contrary from Appellants, that the Examiner (Ans. 4) has set forth an articulated line of reasoning which establishes that the advertisement

insertion teachings of Rosenberg which draw a user's attention to the advertisement because of the pausing of the displayed content item, would have served as an obvious enhancement to the content item display system of Knepper. According to *Leapfrog*, when a combination of familiar elements according to methods known to the skilled artisan achieves a predictable result, it is likely to be obvious.

We recognize that Appellants have attacked the Examiner's reliance on the Rosenberg reference with the contention that Rosenberg is not a valid prior art reference. In Appellants' view (App. Br. 15), paragraph [0009], relied upon by the Examiner, of Rosenberg's published application, which was filed after the filing date of the present application, has no support in the provisional applications from which it claims priority.

We do not find Appellants' argument to be persuasive. We agree with the Examiner (Ans. 21) that the disclosure in the last paragraph of page 8, as well as the "Pause Ads" section beginning at page 21, of Rosenberg's incorporated by reference provisional application (US 60/240,714) provides support for the disclosure at paragraphs [0009] and [0015]-[0017] in the cited Rosenberg reference.

For the above reasons, since it is our opinion that the Examiner has established a prima facie case of obviousness which has not been overcome by any convincing arguments from Appellants, the Examiner's 35 U.S.C. § 103(a) rejection of independent claims 62, 71, and 79, as well as dependent claims 66, 68, 70, 72, 74, 77, 80, 82, 83, 85, and 89, not separately argued by Appellants, is sustained.

Dependent claims 63, 69, 73, and 81

The Examiner's obviousness rejection of these claims is sustained as well. We find no error in the Examiner's finding (Ans. 22-23) that Knepper's description (¶ [0081]) of the CPCLSI and CPCLSE tags as being positive and negative association tags which correspond to the permitted and prohibited ad type specifiers as claimed. Similarly, we also find no error in the Examiner's finding that Knepper's description (¶ [0034]) of the development of the instruction set delivered to the client, which includes the order of the entertainment and advertisement media files that make up the requested show, corresponds to the "ad entry generator" as claimed.

Dependent claims 65, 84, and 86

We also sustain the Examiner's obviousness rejection of dependent claims 65, 84, and 86. While Appellants contend (App. Br. 17-18) that Knepper's disclosed invention is directed to providing alternatives to traditional media file streaming and would not be applicable to the claimed television broadcasting of media files over the airwaves, we do not find such arguments to be persuasive. We find no error in the Examiner's finding (Ans. 5, 6, 15, 23, and 24) that Knepper's disclosure of pre-caching media content at the client side, which could obviously be provided by a transferable recordable medium, so that it is readily available at the time of requested playback would have obvious applications to systems which broadcast media files over the airwaves.

Dependent claims 87, 88, and 90

The Examiner's obviousness rejection of dependent claims 87, 88, and 90, which specify that the "info segment" identifies a "play specific" condition such as a user initiated pause condition, is sustained as well. As discussed *supra* with respect to the Rosenberg reference, we agree with the Examiner (Ans. 16 and 22) that an ordinarily skilled artisan would have recognized and appreciated that to include the detection of a user initiated pause condition for advertisement insertion, as taught by Rosenberg, in the instruction set transmitted from the server to the client in Knepper would have been an obvious enhancement.

II.   THE REJECTION OF CLAIMS 64, 67, 75, 76, and 78 BASED ON THE COMBINATION OF KNEPPER, ROSENBERG AND ZIGMOND.

This rejection is sustained as well. With respect to dependent claim 64, we find no error in the Examiner's finding (Ans. 16, 17, and 24) that Zigmond discloses (col. 10, ll. 64-67) the storing, at a user's premises, of information identifying the content of television programs. We further find no error in the Examiner's determination (*id.*) that an ordinarily skilled artisan would have recognized from Zigmond's further disclosure (col. 11, ll. 1-2 and ll. 45-46) that the stored identifying information, which is associated with specific time slots and program channels, would correspond to the "electronic programming guide" as claimed.

We also agree with the Examiner (Ans. 17), with respect to dependent claims 67 and 75, that Zigmond (col. 12, ll. 1-14) discloses the transmitting of an "info segment" to a user's receiver without the user's request. As also

alluded by the Examiner, (Ans. 24), Knepper's disclosure (¶¶ [0032]-[0034]) of automatically delivering show content to a client without any client interaction buttresses the disclosure found in Zigmond.

With respect to the airwave transmitting and recordable medium delivering features of dependent claims 76 and 78, we refer to our previous discussion of claims 65, 84, and 86 which found that these features were taught and suggested by the disclosure of Knepper.

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that Appellants have not shown that the Examiner erred in rejecting appealed claims 62-90 for obviousness under 35 U.S.C. § 103.

DECISION

The Examiner's 35 U.S.C. § 103 rejection of claims 62-90, all of the appealed claims is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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